

REMARKS/ARGUMENTS

Status of Claims

Claims 1-9 and 20-25 are currently pending in the application. Claims 1-9 and 20-25 have been amended. No new matter is added by these amendments. No claims have been added or cancelled. Therefore, claims 1-9 and 20-25 are present for examination. Claims 1 and 20 are independent claims. Applicant respectfully requests reconsideration of this application as amended.

35 U.S.C. §103 Rejection, Teicher in view of Armetta, further in view of Hirka

Claims 1-9 and 20-25 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,076,075 to Teicher (“**Teicher**”) in view of U.S. Patent No. 5,864,830 to Armetta et al. (“**Armetta**”), and further in view of U.S. Patent Application Publication No. 2003/0061157 A1 to Hirka et al. (“**Hirka**”). Claims 1-4, 6-9 and 20-25 have also been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0061093 A1 to Todd (“**Todd**”) in view of U.S. Patent No. 6,070,153 to Simpson (“**Simpson**”), and further in view of Hirka. Applicants respectfully traverse the obviousness rejections. To establish a *prima facie* case of obviousness, all claim limitations must first be taught or suggested by the prior art. *See, e.g., DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (*citing In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). The Examiner must then provide an explicit analysis supporting the rejection. *See KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (“a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”). While the Examiner can choose one of several exemplary rationales from the MPEP to support an obviousness rejection under *KSR*, all the rationales still require the

Examiner to demonstrate that all the claim elements are shown in the prior art. *See* MPEP § 2143, Original Eighth Edition, August 2001, Latest Revision July 2008.

Claim 1:

Missing Limitation: “wherein the instrument includes a single identifier such that a merchant is able to access funds from both the credit account and the stored value account with the single identifier”

Claim 1 requires “wherein the instrument includes a single identifier such that a merchant is able to access funds from both the credit account and the stored value account with the single identifier.” In other words, a merchant need only the single identifier to access the credit account or the stored value account. The Examiner states that neither Teicher nor Armetta teaches this limitation. *See Office Action*, p. 3. Further, the Examiner states that neither Todd nor Simpson teaches this limitation. *See Office Action*, p. 8. In both instances, the Examiner relies on Hirka. The relevant section of Hirka cited by the Examiner is as follows:

The present invention provides a single card having the benefit of accessing multiple accounts and if desirable multiple types of accounts. This is *accomplished through the routing of card transactions based on additional information beyond the single account number read at the time of sale*. The financial card of the present invention may have the benefits of a credit card, a bank card, and a stored value card. This *multiple account advanced payment card may be encoded with credit card account, bank account, and stored value account information*. The information is encoded on the card in manner that is machine readable in systems that read credit cards, in a systems that reads bank cards, and in at least one system that reads stored value cards. The multiple account payment card may also be processed through a system that permits the card to access different accounts. The multiple account advanced payment card enables the issuer of the card to maintain multiple types of accounts for access by the cardholder. The card enables the cardholder to employ a single card to conduct transactions by accessing different accounts.

Hirka, ¶ [0008] (*emphasis added*).

As can be seen by the emphasized portion of Hirka, Hirka does not teach a single identifier allowing access to both a credit and a stored value account. Rather, Hirka teaches a single physical card having identifiers for each account stored thereon. Indeed, Hirka states that

the “multiple account advanced payment card may be *encoded with a credit account, bank account, and stored value account information.*” *Hirka*, ¶ [0008]. *Hirka* is replete with description of separate identifiers. *Hirka* states that the “machine readable data included on the card includes data pertain[ing] *sic* to different accounts.” *Hirka*, ¶ [0016]. The card provides “for the data to be located on multiple tracks on the magnetic stripe.” *Hirka*, ¶ [0017]. Therefore, *Hirka* does not describe a single identifier used to access multiple accounts as recited in claim. Claim 1 is allowable over the cited art for at least this reason.

Motivation to Combine

The Supreme Court in *KSR* specifically stated that obviousness is shown only if “the subject matter *as a whole* would have been obvious at the time the invention was made.” *KSR*, 127 S. Ct. at 1734 (*emphasis added*). In other words, the Examiner must provide a motivation to combine all references together to show the entire subject matter of the claim as obvious. However, all material must be considered, including teaching away from the combination. “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” M.P.E.P. § 2141.02 (*citing W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)).

Beyond the fact that the card described in *Hirka* includes different identifiers for the different account, *Hirka* specifically teaches against the combination made by the Examiner. *Hirka* states that information other than a single identifier is needed to access multiple accounts. “The present invention provides a single card having the benefit of accessing multiple accounts and if desirable multiple types of accounts. This is accomplished through the routing of card transactions based on additional information beyond the single account number read at the time of sale.” *Hirka*, ¶ [0008]. *Hirka* teaches that more information is needed beyond the single identifier. Thus, *Hirka* teaches away from a single identifier used to access multiple accounts. The Examiner’s motivation for the combination is thus improper. Claim 1 is allowable over the cited art for at least this reason.

Claims 2-9:

Claims 2-9 each depend, either directly or indirectly, from allowable independent claim 36. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." M.P.E.P. § 2143.02 (*citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Therefore, claims 2-9 are also allowable over the cited art due, at least in part, to this dependence on an allowable base claim.

Claim 20:

Claim 20 includes the same or similar limitations to allowable claim 1. The Examiner explicitly recognizes this similarity. *See Office Action*, p.10. Thus, claim 20 is allowable over the cited art for the same or similar reasons.

Claims 21-25:

Claims 21-25 each depend, either directly or indirectly, from allowable independent claim 20. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." M.P.E.P. § 2143.02 (*citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Therefore, claims 21-25 are also allowable over the cited art due, at least in part, to this dependence on an allowable base claim.

Appl. No. 10/694,924
Amdt. dated February 5, 2009
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 3693

PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. Applicants do not acquiesce to any objection, rejection, or argument not specifically addressed herein. Rather, the Applicants believe the amendments and arguments contained herein overcome all objections, rejections, or arguments.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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